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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,247	06/23/2000	Raanan Liebermann	00-422RE	9739

7590 08/12/2003

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EXAMINER

WOO, STELLA L

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,247

Applicant(s)

LIEBERMANN, RAANAN

Examiner

Stella L. Woo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-32, 46 is/are allowed.
- 6) ☒ Claim(s) 33-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 1996 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Reissue Application

1. Claims 33-45 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. *See Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

During the original prosecution, the examiner issued an Office action, mailed October 1, 1997, rejecting independent claims 1, 12, and 26 based on the prior art references of Kurokawa, Rogers and Abramatic. In a response to the Office action, applicant amended independent claims 1, 12 and 26 by further defining the video apparatus as “visually observing the images of *facial* and hand and finger signing motions of a deaf person and converting the observed signing motions into digital identifiers,” further defining the means for translating as “translating said digital

identifiers of said observed signing motions into words and phrases,” and further defining the means for outputting as “outputting said words and phrases generated by the visual observation of said signing motions in a comprehensible form to another person” (underlining shows added subject matter). The applicant stated that “[t]he independent claims have ...been amended to clarify the unique operation and structure of the present invention. More particularly, each of the independent claims clearly defines the first step of the method or one component of the apparatus as visually observing the **facial**, finger and hand motion of the deaf person and converting those signing motions into digital identifiers which are then translated into words and phrases.” The applicant specifically argued that “[b]ecause of the technology employed by Applicant in the novel method, the full range of signing motions can be observed, including hand motion, finger motion including interdigitation, body motion, lip motion and **facial motion**... None of the prior art can approach the apparatus and method of the present invention from the standpoint of recognition of all these forms of signing activity.” Therefore, the subject matter previously surrendered in the application for the patent is a system without the following limitations: a video apparatus for visually observing the images of **facial** and hand and finger signing motions and converting the observed signing motions into digital identifiers, a means for translating said digital identifiers of said observed signing motions into words and phrases, and a means for outputting said words and phrases generated by the visual observation of said signing motions.

The limitations omitted in the newly added claims 33-45 of the reissue are the same limitations added by the applicant for the purpose of obtaining allowance in the original prosecution, as clearly stated in applicant's arguments during the original prosecution, and applicant is now precluded from recapturing subject matter previously surrendered. The applicant cannot acquire, through reissue, claims that are the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 33, 35-36, 38, 40-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakiyama et al. (US 5,659,764, hereinafter "Sakiyama").

Sakiyama discloses an electronic communication system for the hearing impaired (note Fig. 22) comprising:

a receiver (microphone 1 and voice recognition unit 2);

means for translating (voice language/sign language translation unit 5' and sign language CG animation generation unit 6 with text display; col. 21, lines 14-30; Figure 23);

means for outputting (text is displayed on monitor 7 used by the hearing impaired person; Figure 23);

said device including means for receiving words and phrases from the hearing impaired person (video camera 21 and sign language word recognition unit 23; col. 16, lines 25-28);

transforming means (signal language/voice language conversion unit 25); and

means for outputting (aurally normal person side display unit 27 with monitor 28).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 34, 37, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakiyama in view of Wycherley et al. (US 5,163,081, hereinafter "Wycherley").

Sakiyama differs from claims 34, 37 and 45 in that it does not specify the translating taking place at a location remote from either party or communication taking place over telephone lines. However, as taught by Wycherley (note Fig. 1), it is well known to centralize the translation process (central station 200) in order to convert communications between an aurally normal person and a remotely located aurally impaired person over the telephone network. It would have been obvious to an artisan of ordinary skill to incorporate such remote communication and centralized translation, as taught by Wycherley, within the system of Sakiyama in order to allow communications between remote parties.

Allowable Subject Matter

I. Claims 1-32 and 46 are allowed because although claims 1-32 and 46 were broadened by deleting the "deaf" limitation, the claims 1-32 and 46 are broader in an aspect unrelated to a prior art rejection made in the original application. Claims 1-32 and 46 recite allowable subject matter because the prior art of record do not show or fairly suggest conversion of observed facial, hand and finger motions to digital identifiers which are then translated into words and phrases.

Response to Arguments

6. Applicant's arguments filed May 22, 2003 have been fully considered but they are not persuasive.

Applicant argues that the "limitation directed to means for outputting the textual material for display on a device utilized by the hearing impaired person is a limitation

which was not prosecuted in the parent case.” However, claims 7 and 19 in the patent recite the display of words and phrases in written form such that the outputting of textual material for display on the hearing impaired person’s device was previously considered in the parent case.

Applicant further argues that the inclusion of the video apparatus during prosecution of the original application was a substantial error and “[u]nder the broadening provisions of 35 USC 251, Applicant is entitled to remove this limitation from the claims and obtain a patent to claims having a combination of elements without this feature.” However, as describe in the rejection above, applicant amended independent claims 1, 12 and 26 in response to a prior art rejection by further defining the video apparatus as “visually observing the images of **facial** and hand and finger signing motions of a deaf person and converting the observed signing motions into digital identifiers,” further defining the means for translating as “translating said digital identifiers of said observed signing motions into words and phrases,” and further defining the means for outputting as “outputting said words and phrases generated by the visual observation of said signing motions in a comprehensible form to another person” (underlining shows added subject matter). The applicant stated that “[t]he independent claims have ...been amended to clarify the unique operation and structure of the present invention. More particularly, each of the independent claims clearly defines the first step of the method or one component of the apparatus as visually observing the **facial**, finger and hand motion of the deaf person and converting those signing motions into digital identifiers which are then translated into words and phrases.”

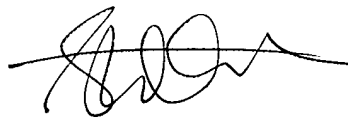
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The visual observation and translation of the facial motions, along with finger and hand motions, were added by the applicant for the purpose of obtaining allowance in the original prosecution. The applicant cannot acquire, through reissue, claims that are the same or broader in an aspect germane to a prior art rejection.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (703) 305-4395.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read 'Stella L. Woo', with a horizontal line extending to the right.

Stella L. Woo
Primary Examiner
Art Unit 2643

SW
August 11, 2003